

Applicants: Ralf Kohn et al.
Application No. 10/014,099
Response to Restriction Requirement

REMARKS

Applicants reserve the right to prosecute the subject matter of the non-elected claims in a divisional application, if such subject matter is not ultimately granted here.

Regarding the traversal, Applicants respectfully request the Examiner reconsider and withdraw the requirement for restriction. Applicants refer the Examiner to MPEP §803 which recites in part: "There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent * * * or distinct as claimed * *
*; and
- (2) *There must be a serious burden on the examiner if restriction is
not required * * *. [All emphasis added.]*

Consequently, the Examiner's authority to insist upon restriction only extends to those situations where the failure to insist upon restriction would subject the Examiner to serious burden.

On the present record, the Examiner has not established that the examination of all seven groups would subject him to a serious search burden. Thus, for example, even though the Examiner shows Groups I-VII to be separately classified at the *subclass* level in order to make out his case for distinctness, the Examiner does not address the search burden issue in any respect. Applicants point out that Groups I, III, IV and VI are still in

Applicants: Ralf Koln et al.
Application No. 10/014,099
Response to Restriction Requirement

the same class. In view of the foregoing, and in the absence of a showing of a serious search burden, Applicants submit that the Examiner is required to examine all of Groups I-VII in this single application, and withdraw the restriction requirement.

Should the Examiner insist on restricting the above-identified application, Applicants submit Groups III and VI should be examined together with Group I. In this regard, Applicant would call the Examiner's attention to the Commissioner's Notice published in the Official Gazette on March 26, 1996, at 1184 OG 86. According to that notice:

"[A]pplicant may be called upon under 35 U.S.C. § 121 to elect claims to either the product or the process. The claims to the non-elected invention will be withdrawn from further consideration. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from and otherwise includes all the limitations of an allowed product claim."


See also MPEP §821.04 ("Rejoinder"). Applicant presumes that the Examiner is proceeding in accordance with this notice, and that Groups III and VI will be rejoined and examined in the event that Group I is found to be allowable. If not, then Applicant would appreciate an explanation from the Examiner of why this notice is not applicable.

Applicants: Ralf Koln et al.
Application No. 10/014,099
Response to Restriction Requirement

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By 
David D. Kim
Reg. No. 53,123

875 Third Avenue
18th Floor
New York, New York 10022